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Masahiro Imaizumi

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42754 7590  
Nields & Lemack  
176 E. Main Street  
Suite #5  
Westboro, MA 01581

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EXAMINER

HON, SOW FUN

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-10, 12 in the reply filed on 9/19/08 is acknowledged. The traversal is on the ground(s) that the technical feature that is common to both Group I and Group II is neither anticipated nor obvious and is hence special. This is not found persuasive for the reasons set forth below.

The requirement is still deemed proper and is therefore made FINAL.

***Request for Reconsideration***

***Rejections Repeated***

2. The 35 U.S.C. 102(b) rejection of claims 1-3, 5-7, 10, 12 as being anticipated by Asano, as evidenced by Wikipedia, is repeated for the same reasons previously of record in the Office action dated 05/08/08.
3. The 35 U.S.C. 102(b) rejection of claims 1-7, 10 as being anticipated by Sumita as evidenced by Wikipedia, is repeated for the same reasons previously of record in the Office action dated 05/08/08.
4. The 35 U.S.C. 103(a) rejection of claims 4, 8 over Asano, as evidenced by Wikipedia, and further in view of Tahara, is repeated for the same reasons previously of record in the Office action dated 05/08/08.
5. The 35 U.S.C. 103(a) rejection of claims 8-9, 12 over Sumita, as evidenced by Wikipedia, and further in view of Tahara, is repeated for the same reasons previously of record in the Office action dated 05/08/08.
6. The 35 U.S.C. 103(a) rejection of claim 9 over Asano in view of Tahara, as evidenced by Wikipedia, and further in view of Sumita, is repeated for the same reasons previously of record in the Office action dated 05/08/08.

***Response to Arguments***

7. Applicant's arguments have been fully considered but they are not persuasive.
8. Applicant argues that the present invention lies in the process comprising a specified dispersion treatment which comprises homogeneously dispersing fine

particles (D) having a specified average particle size in a specified resin (C) dissolved in a solvent (B) using a wet dispersion (A), wherein because the solvent (B) is not an ingredient of the sealing material, in order to realize the condition for said specified dispersion treatment, solvent (B) is first added to the wet dispersion unit (A) and removed after the dispersion treatment, whereby during this specified dispersion treatment, the fine particles (D) and the reactive resin (C) receive a very complex action from the media (b) contained in a dispersion vessel (a) and colliding with each other in a high-speed rotating field, which action is characteristic of a dispersion treatment in a wet dispersion treatment, where the structure including the size, shape, surface condition and the like of the fine particles (D) as well as the dispersion state of the fine particles (D) in said reactive resin (C) is believed to be brought to a special state which will not be realized by other types of dispersion treatment.

9. Regarding Asano, Applicant argues that Asano [makes no distinction between] a sand mill, a three-roll mill and a ball mill where the examples only contain a three-roll mill, and thus fails to teach the use of a ball mill or a sand mill for the purpose of obtaining better results thereby.

Applicant is respectfully apprised that the use of a ball mill or a sand mill as a wet dispersion mixer is well known in the mixing art. Asano teaches the objective of producing a sealing material by homogeneously dispersing (mixing uniformly, Detailed Description, [0037]) fine particles (D) having an average particle size of not more than 3  $\mu\text{m}$  (essential component (e) filler, abstract) in a reactive resin (C) having an epoxy group and (meth)acryloyl group (acrylic or methacrylic acid, Detailed Description,

[0014]) combined with dissolution mixing of the epoxy resin of many organic functions (Detailed Description, [0037]), thus highlighting the need for a combination of homogenous dispersion of the composition and dissolution mixing of the epoxy resin which is the objective of Applicant. The three-roll mill is better associated with the compounding of semi-solid elastomeric compositions, while the ball mill or sand mill is better suited for wet dispersions and thus better suited for the desired homogeneity of dispersion combined with dissolution mixing of the epoxy resin which implies some form of wet state.

10. Applicant argues that both Asano and Sumita only teach a three-roll mill as a disperser in the examples.

Applicant is respectfully apprised that the use of a ball mill or a sand mill as a wet dispersion mixer is well known in the mixing art. The three-roll mill is better associated with the compounding of semi-solid elastomeric compositions, while the ball mill or sand mill is better associated with wet dispersions and thus better suited for the desired homogeneity of dispersion of a composition comprising the epoxy resin which is syrupy and difficult to handle uniformly and hence properly homogenize on a three-roll mill.

11. Applicant argues that after the specified dispersion treatment, the structure including the size, shape, surface condition of the fine particles as well as the dispersion state of the fine particles (D) in said resin (C) are believed to be brought to a special state that will not be realized by other types of dispersion treatments.

Applicant is respectfully apprised that the beliefs of counsel can not take the place of factually supported objective evidence in the record. See MPEP 2145 and

716.01. Furthermore, it is noted that the features upon which Applicant relies (i.e., the special state which is the specific combination of final size, shape, surface condition of the fine particles and dispersion state of the fine particles (D) in said resin (C)) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. Applicant argues that this special state is very difficult to exactly define since the action from the media (b) is very complex, and is thus defined by the process.

Applicant is respectfully apprised that due to Applicant's clarification that the special state is very difficult to define due to the complex action from the media (b), the specific combinations of sealing composition and process steps need to be defined in as much detail as possible to clearly distinguish these "special states" from those that may be inherent in the prior art. As such, the scope of the present claims is not commensurate with the specific combinations of sealing composition and process steps that are described in the examples of Applicant's specification.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sow-Fun Hon whose telephone number is (571)272-1492. The examiner can normally be reached Monday to Friday from 10:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks, can be reached on (571)272-1401. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sophie Hon/  
Examiner, Art Unit 1794

/KEITH D. HENDRICKS/  
Supervisory Patent Examiner, Art Unit 1794